

REMARKS

An Office Action was mailed on September 23, 2004.

Claims 1-8 are pending, of which claims 1, 6, and 8 are independent claims. By the foregoing, claims 1, 6, and 8 are amended to obviate an objection. The rejections of all claims are herein traversed.

Claim 1-8 are objected to for lacking proper format. All independent claims are amended to obviate the objection. Accordingly, the Examiner is respectfully requested to withdraw the objection.

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) to non-patent reference "Slot Machines A Pictorial Review- 1973 Bally 'Circus'" (Bally "Circus"). The rejection is respectfully traversed.

Before turning to the substantive arguments, Applicant wishes to revisit the claimed invention. As claimed by each independent claim the present invention is a game machine comprising a display means and a game control means for playing a spinning reel game where each reel carries symbols from a set of symbols. If a predefined winning event occurs, the gaming machine pays a prize.

In claim 1 and 6, the set of symbols includes at least one scatter symbol, claim 1, or special symbol, claim 6. In at least one reel, the set of symbols includes a plurality of scatter or special symbols, which are separated from each other on the reel by no more than one other symbol position. The winning event occurs when more than one scatter or special symbol in the least one reel is displayed with scatter or special symbols on any of the other reels.

Thus, claims 1 and 6 claim a gaming machine wherein the winning symbols are separated by exactly one space on at least one of the reels and that in order to win on the claimed gaming machine the winning symbols of the at least one reel must be shown and furthermore that it is not required to have winning symbols on all of the remaining reels.

In claim 8, the set of symbols includes certain symbols. A winning combination is made up of a greater number of the certain symbols than there are columns displayed on the display.

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The cited reference, Bally "Circus", does not teach, disclose or reasonably suggest the claimed invention of independent claims 1, 6, or 8 nor is the motivation to modify the reference to arrive at the presently claimed invention.

To a person of ordinary skill in the art Bally "Circus" teaches a gaming machine having only one scatter symbol per reel – as conceded on page 5, lines 4-7 of the Office Action. Even if not conceded, this is implicit in the fact that the Bally "Circus" is a three reel machine with 27 possible three-scatter symbol combinations.

To arrive at the presently claimed invention of claims 1 and 6, one skilled in the art would have to modify at least one reel to add a second winning symbols exactly one position apart from the existing winning symbol. The skilled artisan would then have to further modify the gaming machine to arrive at the claimed predefined winning event. To do so the skilled artisan would have to determine that not all reels are required for winning payout, specifically select the at least one modified reel and further arrange for the reels to have the appropriate display during the winning event so that that it is not required to have winning symbols on all of the remaining reels.

To arrive at the presently claimed invention of claim 8, one skilled in the art would have to modify at least one reel to add a second winning symbols. The skilled artisan would then have to further modify the gaming machine to arrive at the claimed predefined winning event. To do so the skilled artisan would have to determine that not all reels are required for winning payout, specifically select the at least one modified reel and further arrange for the reels to have the appropriate display during the winning event so that that it is not required to have winning symbols on all of the remaining reels

Applicant respectfully submits that this could not be done without impermissible hindsight where the present invention was used as a roadmap. In fact, Bally "Circus" does not teach, disclose, or suggest increasing the number of scatter symbols, or the like, and as described below, nor, as further described below, arranging scatter symbols in the manner claimed.

In relation to claims 1, 6 and 8, it is conceded that the feature of

"at least one of the reels, the set comprising a plurality of the scatter symbols at least certain of the scatter symbols on said at least one reel being separated from each other on the reel by no more than one other symbol position, so that, when more than one scatter symbols occurring on any of the other reels at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols"

is not disclosed in the prior art. The claims stand rejected on the basis that it would be obvious to one having ordinary skill in the field would incorporate more than one scatter symbol on at least one reel in a gaming machine in order to "increase the probability that a play will obtain scatter symbols and hence an award of a scatter symbol combination making the gaming machine highly desirable to players."

In coming to this view, Applicant respectfully submits that the claimed invention does not merely add extra scatter symbols to the reels, but does so in a particular way, namely such that *"a plurality of the scatter symbols are ... separated from each other on the reel by no more than one other symbol position"*. This particular arrangement of scatter symbols would not be one which is ordinarily selected by a game designer.

There is no motivation in the reference to modify the game machine in this manner. In fact, the claimed arrangement of scatter symbols would have been specifically avoided by one having ordinary skill in the field, rather than being chosen, as it prevents the use of the standard method of determining the return to player percentage for the game.

The calculation of return to player percentage is crucial in the gaming industry, and must be kept within strict bounds for both regulatory reasons and reasons involving player and game operator acceptance. Therefore, any game modification that makes a gaming system depart from known methods of calculating this parameter (and other parameters) would be avoided by game designers.

In contrast, if a designer wanted to simply add more scatter symbols to increase the return to player, as is being suggested in the Office Action, one having ordinary skill in the art would have

ensured that one reel could not display multiple scatter symbols in any rotational position, as in this case the standard return to player calculation method holds.

It should also be noted that the particular arrangement of scatter symbols claimed results in winning scatter symbol combinations that are not seen in the prior art and are not possible with other arrangements of multiple scatter symbols on a single reel. For example, a 5-reel machine, having three visible symbol positions on each reel, and two (2) scatter symbols on each reel, which embodies the present invention could result in a ten (10) scatter symbol combination.

Combinations as claimed in claims 7 and 8, in which there are more scatter symbols displayed in a winning symbol combination, than there are reels on the machine, constitute a new type of prize winning combination which has not been contemplated or suggested in any of the cited references, and would therefore not be obvious to those having ordinary skill in the field.

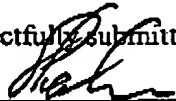
All dependent claims are allowable for at least the same reasons as the independent claim from which they depend.

Applicant has fully responded to each matter of substance raised in the Office Action and believes that the case is in condition for allowance. Withdrawal of the rejection and allowance of the application is therefore courteously solicited. Should the Examiner have any requests, questions or suggestions, the Examiner is invited to contact Applicant's attorney at the number listed below.

The Examiner is kindly requested to note the change in attorneys' docketing to FRHL/3245 (333832-00005).

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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